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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/738,591 | 12/15/2000 | Jim Otter | 60,246-116 | 1229 |

26096 7590 07/18/2003

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EXAMINER

PARKER, FREDERICK JOHN

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1762

DATE MAILED: 07/18/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/738,591

Applicant(s)

OTTER, JIM

Examiner

Frederick J. Parker

Art Unit

1762

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 July 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): claim objection to claim 27; 35 USC 112 rejection of claim 24.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

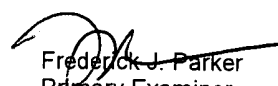
The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 27.

Claim(s) objected to: _____

Claim(s) rejected: 1-5, 7, 20-23, 25, 26 and 28.Claim(s) withdrawn from consideration: 8-19.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____


Frederick J. Parker
Primary Examiner
Art Unit: 1762

Continuation of 5. does NOT place the application in condition for allowance because: Applicant argues on page 8 that he "is claiming a method of making a film including a series of steps". This argument is inaccurate and therefore does not properly address the Examiner's final rejection. Claim 1 is directed towards making a film which is then added to/ used with a heat transfer component. The Examiner's position has been that it would have been obvious to either apply a film to the heat transfer component and then apply polar particulates thereon, or per Applicant's claim 1 apply the polar particulates to the film and then apply the particle-containing film to the heat transfer component. The Examiner stands by this position for all the reasons detailed in the previous Office Actions. It remains his position that they are merely obvious variations within the purview of one of ordinary skill because the skilled artisan would have expected identical results, a position which the Applicant has failed to contest and has not produced evidence to the contrary. The mere fact the claims provide slightly different means to achieve the same end does not imply patentability because the difference of the instant claims would have been obvious in view of the cited prior art for the reasons stated, and there is no evidence of synergistic or unexpected results to be derived from the difference. Therefore the Examiner maintains the rejection of claims 1-5, 7, 20-23, 26-28, 28.